

REMARKS

In the application claims 1-4, 9-12, 14, 20, and 22-28 remain pending and presently stand rejected. Claims 5-8, 13, 15-19, and 21 have been canceled without prejudice. The claims have been amended to more distinctly recite what is regarded as the invention. Support for the amendments may be found in the application as originally filed and no new matter has been added. Owing to the amendments, the reconsideration of the rejection of the claims is respectfully requested.

In the Office Action, claim 28 was rejected under 35 U.S.C. § 112. In response, claim 28 has been amended to recite that the elements of the graphical user interface (302 of Fig. 3) remain dark when the controlling device is placed into the second mode of operation. Since this amendment is supported by the application as filed, see page 6 lines 9+ and Fig. 3, it is respectfully submitted that the rejection under 35 U.S.C. § 112 must be withdrawn. Furthermore, since this claimed element is clearly illustrated in the figures, e.g., Fig. 3, it is respectfully submitted that the objection to the drawings must also be withdrawn.

The pending claims generally stand rejected under 35 U.S.C. § 103 as being rendered obvious over Kim (U.S. 6,466,154) as modified by Lu (U.S. 2003/0107552). In response to this rejection, it is respectfully submitted that, when evaluating a claim under 35 U.S.C. § 103, it is impermissible to break the claim into its component parts and then merely find a reference containing one part, another reference containing another part, etc., while using the disclosure of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection based upon a combination of references requires a demonstration that an artisan of ordinary skill in the art at the time of the invention would have selected the various parts from the references and combined them in the claimed manner. It is additionally impermissible to pick and choose from a reference

only that which may support a position of obviousness while disregarding what a reference fairly teaches in its entirety.

Considering now Kim, while Kim discloses a device that supports both a remote controller and a wireless mouse, it is respectfully submitted that the device disclosed within Kim operates in a manner that is entirely in contrast to that which is claimed. In this regard and as acknowledged in the rejection of the claims, Kim discloses the desirability of providing a device having a user interface (110) having two *separate and distinct* subsets of keys, namely, a first subset of keys (111) which are used *only* to send control signals to a television and a second subset of keys (112) which are used *only* to send control signals to a computer. That Kim desires to keep the first subset of keys (111) separate and distinct from the second subset of keys (112) is further evidenced by the embodiments illustrated in Figs. 5-7 in which Kim goes so far as to employ a cover to physically separate the first subset of keys used to send control signals to a television from the second subset of keys used to send control signals to a computer.

In direct contrast to that which is illustrated and described within Kim, the invention claimed has the advantage, unappreciated by Kim, of providing a user interface in which elements of the user interface may be made selectively active thus allowing elements of the user interface to be *shared* between a first mode of operation wherein a first subset of the user interface elements are activatable to cause the controlling device to transmit control data signals to control functions of a first appliance and a second control mode wherein a second subset of the user interface elements of the controlling device which includes at least one user interface element within the first subset are activatable to cause the controlling device to transmit control data signals to control functions of a second appliance. Accordingly, it will be appreciated that Kim not only fails to disclose, teach, or suggest the invention claimed but, when considered in its entirety, teaches directly against the invention claimed.

Like Kim, Lu also discloses a computer mouse (108) in which two *separate and distinct* sensors, namely, a first sensor (114) which provides the “desk-bound” function of the mouse (108) and a second sensor (120) which provides the “freely-movable” function of the mouse (108), are made *separately* active as a function of the condition of a switch (124). Thus, like Kim, Lu also fails to disclose, teach, suggest, or even appreciate the advantages obtained by the claimed invention which result from using a condition sensed by a sensor to selectively enable user interface elements in a user interface having user interface elements that are *shared* between two operating modes. Furthermore, by the express teachings of Kim, Kim, at best, suggests nothing more than modifying the device of Kim to use a condition sensed by the switch (124) - which in Lu is used to enable one of two *separate and distinct sensors* - to similarly enable one of the nevertheless *separate and distinct* first subset of keys (111) or second subset of keys (112) of the device of Kim. Since such a modification is clearly not that which is claimed, it is respectfully submitted that the combination of Kim and Lu fails to establish a *prima facie* case of obviousness and the rejection under 35 U.S.C. § 103 must be withdrawn.

It is further respectfully submitted that modifying the device of Kim whereby selected elements of the user interface (110) are selectively enabled and *shared* between two different operating modes as claimed would impermissibly change the principle of operation of the Kim device. In this regard and as discussed above, Kim, when considered in its entirety, expressly teaches the desirability of keeping the first subset of keys (111) *separate and distinct* from the second subset of keys (112). For this yet further reason that it is respectfully submitted that the claims should be deemed to be allowable.

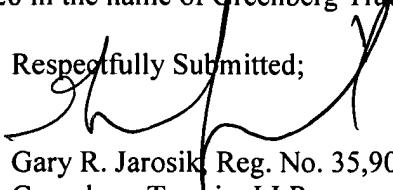
#### CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be

determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

  
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By: